

## REMARKS/ARGUMENTS

### Restriction Requirement

Claims 1-48 are pending in the present application. In the Office Action dated October 3, 2003, a restriction was required as to one of eight groups of claims, identified as Groups I-VIII. In the Office Action, the claims of Groups I, II, and V were identified by the Examiner as follows: Group I (Claims 1-30), drawn to a method to determine if a sample of cells contains dysplastic or carcinomic cells; Group II (Claim 31), drawn to a method of diagnosing a patient for early-stage cancer or a precancerous condition, and Group V (Claims 35-36), drawn to a method of detecting dysplastic or carcinomic cells in selected target tissue of a patient. Applicant notes with appreciation that in a telephone conference held on October 16, 2003 with the undersigned attorney, Examiner Winston indicated that Groups I, II, and V may be rejoined.

The remainder of the Groups identified by the Examiner in the Office Action remain restricted. Applicant respectfully traverses the restriction requirement. Applicant reserves the right to request reinstatement of non-elected claims as appropriate upon notice of allowance.

Two criteria must be met in order for a requirement for restriction to be proper: (1) the inventions must be shown to be independent and distinct; and (2) there must be a serious burden on the examiner. See MPEP § 803. Indeed, if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions. Without commenting on whether the various Groups are distinct from each other, Applicant respectfully submits that it would cause no serious burden to the Examiner to search more than one of the remaining Groups.

Applicant respectfully submits that examination of the claims of Groups III and IV, drawn to methods of prognosing a patient's response to cancer therapy employing the method of Claim 1, along with examination of rejoined Groups I, II, and V (discussed *supra*), would not impose a serious burden on the Examiner. A reasonable search for the methods of rejoined Groups I, II, and V would encompass, at a minimum, a search for the claimed methods of prognosis. Applicant respectfully proposes that, at a minimum, the claims of

DOCKET NO.: BIOD-0026  
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Office Action Dated: October 3, 2003

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Groups III and IV should be rejoined with Groups I, II, and V, since the examination of Groups I, II, III, IV and V would clearly not impose a serious burden on the Examiner. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the restriction requirement.

**Provisional Election Under 37 C.F.R. § 1.143**

Nonetheless, to be fully responsive, in accordance with 37 C.F.R. § 1.143, Applicant hereby provisionally elects for prosecution the subject matter of rejoined Groups I (Claims 1-30), II (Claim 31), and V (Claims 35-36). This affirms the provisional election made with traverse during the telephone conference between the undersigned attorney and Examiner Winston on October 30, 2003.

Applicant reserves the right to prosecute the claims of non-elected groups in one or more future continuing and/or divisional applications.


**Amendments to Claims**

Claims 13, 27, 28 and 48 have been amended to correct typographical errors. No new matter has been added.

**Conclusion**

Applicant believes that the foregoing constitutes a complete and full response to the Office Action of record. An early and favorable consideration of the present application is respectfully requested.

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